

REMARKS

Claims 1-7, 11-22, 31 and 32 are now pending in the application. By this amendment, claims 1-4, 6, 11-14 and 18 have been amended. The amendments to the claims contained herein are of equivalent scope as originally filed and, thus, are not a narrowing amendment. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-2, 4-7, 11-12, 14-16, 18-22 and 31-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Snyder (U.S. Pat. No. 6,038,561) in view of Risen, Jr. et al. (U.S. Pat. No. 6,018,714). Claims 3 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Snyder in view of Risen, and Newman (U.S. Patent 5,774,833). Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Snyder in view of Risen, and Rivette (U.S. Patent 6,339,767). These rejections are again respectfully traversed.

First, the Applicants' would like to respectfully note that the Examiner's present rejections appear to be substantially the same, if not identical, to the rejections made in the February 2, 2005, Office Action. Applicants' appealed from that rejection on May 4, 2005 and submitted a full Appeal Brief on these rejections on June 30, 2005.

In response to Applicants' Appeal, the Examiner reopened prosecution and cited a new grounds of rejection (Barney et al). The Barney reference was ultimately shown not to constitute prior art.

Thus, it appears that the applicants' and the Examiner are now back at the point where we were in May 2005, when applicants' filed their appeal. Applicants argued at that time, and continue to argue that there is at least one important difference between their invention and the cited art. Applicants' generate their claim breadth metric automatically by using computer to measure claim length.

Regarding the art of record, the Examiner has recognized that Synder does not:

"automatically analyze the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric that is associated with a claim is indicative of how broad the claim is.

wherein the claim breadth metrics are used to analyze the multiple claims." [See Office Action page 6].

It is the Examiner's contention that Risen supplies the missing step, in that Risen introduces "metrics" which the Examiner construes to include claim breadth metrics. However, Risen does not teach the process of automatically determining claim breadth metrics for multiple claims. On the contrary, Risen relies on a human to assess the claim breadth in arriving at a claim breadth metric.

In order to more fully emphasize that applicants are automatically determining claim breadth metrics, claim 1 has been amended to recite that the automatic determining step is performed by using computer to measure claim length,

For the convenience of the Examiner, applicants have also appended a portion of their June 30, 2005, Appeal Brief to this response. The appended portion illustrates that Risen does not teach or suggest automatic determination of claim breadth metrics using computer to measure claim length.

Another difference between applicants' invention and the art of record lies in the fact that applicants (as now recited in claim 11) automatically analyze the retrieved text to identify the independent claims and then use these identified claims to generate claim breadth metrics.

The Snyder reference relied upon by the Examiner appears to have some knowledge of independent claims and dependent claims, because in computing the similarity between claim X from one patent A with claim Y from another patent B, the Snyder algorithm must blend in the meaning from the independent and dependant parts of claims of X and Y (to create a "combined score" for each). This is not discussed at length in Snyder, but some indication of this feature may be found in Snyder claims 45, and from the following excerpt from Snyder:

In accordance with one aspect of the invention, the user may select a metric that captures the essence of the document or documents under analysis. For example, the legal concept of patent infringement may be applied to sets of patents or patent applications. In a particular embodiment, a similarity matching algorithm treats the exemplar part of a patent claim differently from the dependent parts of the claim. Thus, a kind of "cross-comparison" matching is used, wherein the combined scores for (1) patent A, claim X dependent and independent part(s) vs. patent B, claim Y, independent part and (2) patent A, claim X dependent and independent part(s) vs. patent B, claim Y, dependent and independent part(s), generate an aggregate matching (or similarity) score for patent A, claim X vs. patent B, claim Y. [col 4, ln 48]

However, it is clear from the above excerpt that Snyder is trying to find subject matter or meaning similarity between two claims. Snyder is not attempting to automatically determine claim breadth by measuring claim length of the independent claims. Moreover, combining the teachings of Snyder and Risen does not achieve applicants' result.

In view of the above-described differences, it is respectfully submitted that the independent claims (which all recite automatic determination of claim breadth metric, and claim 11 which additionally recites automatically identifying the independent claims) fully distinguish applicants' invention from the cited art, as combined by the Examiner.

Amendments to the dependent claims:

In order to still further distinguish the applicants' invention along these lines, dependent claims 2-4, 6, 12-14 and 18 have been amended to refine the claim language so that it will more accurately fit with the antecedent basis provided by the independent claims. In studying the Examiner's office action, applicants noted that these dependent claims had language ("analyzing the claim text") that corresponded to the antecedent basis of the parent claims as originally filed. These claims have now been corrected to better match the present language of the parent claims.

In addition, these claims have been further amended to make it more clear that the recited step(s) for performing the automatic claim breadth determination are also performed by automatic means, which further distinguish applicants' invention from the cited combination.

Remarks concerning MPEP 2144.04:

In view of the analysis of the Risen reference, presented above and in the attached excerpt from applicants' prior Appeal Brief, applicants respectfully submit that Risen does not provide a teaching of applicants' automatic claim breadth metric determination. Applicants' are aware of MPEP 2144.04 III (the Examiner cited this in the February 9, 2005, Office Action), which cites a 1958 CCPA case, *In re Venner*, involving automating a manual activity. As stated in the MPEP at 2144.04, the examiner may use the rationale used by the court, if the facts in a prior legal decision

are sufficiently similar. In the present case, however, In re Venner, does not fit our facts at all. The Examiner used this as a basis for rejection in February 2005, but did not include it as a basis in the present rejection. Applicants' are nevertheless addressing this issue now, to show why In re Venner does not apply.

In Venner, the patentability an apparatus for molding aluminum and magnesium alloys was at issue. The problem was knowing when to withdraw the finished article from the mold. The alleged patentable feature was a floor switch activated timer that told when enough time had elapsed to open the mold and retrieve the article. However, a human operator still had to first calculate the time required, so that the countdown timer could be preset. In Venner, the court found that using a timer (to measure time), where the preset time was arrived at by mental calculation, did not add any patentable weight to the claim. Thus, in that context, the use of "automation" was deemed obvious.

Applying the logic of In re Venner to the present situation, we can see that Venner is more like Risen: the human operator presets the timer setting in Venner; the human operator determines and stores a claim breadth metric in Risen. In the applicants' invention, the claim breadth metric is generated by the computer automatically. Thus it is respectfully submitted that the decision in In re Venner is based on facts that are substantially different from the applicants' present situation. Accordingly, it is respectfully submitted that MPEP 2144.04 III is not applicable here.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is

believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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By: Gregory Stobbs
Gregory A. Stobbs
Reg. No. 28,764

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

group as follows for purposes of the 37 C.F.R. 1.192(c)(7) "Grouping of Claims" requirement:

Group I – Claims containing recitation of claim breadth metric
Claims in this group include independent claims 1, 31, 32

ARGUMENT

The Examiner had admitted that Snyder does not teach the steps of:

- b) automatically determining claim breadth metrics for the multiple claims;
- c) associating said claim breadth metric with said claim text and storing said associated metric in a computer-readable dataset; and
- d) wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is. [See Office Action of 5/6/2004, page 3).

The Examiner cites Risen as teaching the step of valuation of the intellectual property asset, based on "the breadth of the claims." [See Office Action of 5/6/2004, page 3-4). However, there is an important component that is lacking from the Risen reference. The Risen reference does not teach the process of **automatically determining** claim breadth metrics for multiple claims. As will be demonstrated below, Risen relies on a human to assess the claim breadth metric.

Illustrative of the fact that Risen relies on human assessment of metrics—as

opposed to automatic determination of them—is the following quote from Risen, col. 14, lines 39-51:

“The relevant parameters are identified for a particular case. The values of some of the parameters can be determined by agreement between the insurance company and the proposed insured. The values of the others are determined by an appropriate evaluation method. The evaluation method could be, for example, one of the methods referred to above, or a method which involves obtaining the opinion of one or more **experts** in the field. The preferred method is to obtain the opinions from the most experienced available **expert** for each issue and to obtain the opinion of two more highly qualified **experts** for those areas where there is reason to consult further or where there is a large financial risk.”

To further aid the Board in evaluating the true scope of the Risen reference, Applicants have conducted a “word search” throughout the text of the Risen reference and present below how the word “claim” is used in Risen specification. It is submitted that if Risen did teach “automatically determining” claim breadth metrics, as the Examiner has presumed, then some language discussing the term “claims” would certainly mention “automatic determination of claim breadth.” In fact, as the following excerpts show, the Risen reference does not teach automatically determining a claim breadth metric.

Excerpts from Risen reference where the word “claims” appears

Excerpt A [col. 9, lines 21-43]

“The second step of valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. For example, if the asset is a patent and if one or more **claims** of the patent are found to be valid and enforceable in the legal analysis, a value is then assigned to the patent. This value can be based, for example, upon the income and profits generated by the sale or use of the patented technology, the number of years remaining on the term of the patent, the **breadth of the patent claims**, the nature of the patented technology, the nature of competitive products or processes, etc. One such method is described below in Prophetic Example 2. Other intellectual property assets can be assigned a monetary value in conventional ways by persons who specialize in, or have the skills needed, to value intellectual property. In another embodiment of the

invention, the prospective purchaser of the intellectual property asset assigns their own value to the intellectual property, similar to the manner in which the U.S. Post Office allows a customer who purchases insurance for a parcel to select the desired amount of insurance coverage. While this latter valuation technique is simpler, it is likely to be more difficult to use in statistically determining an appropriate insurance premium.”

Excerpt A is the text relied upon by the Examiner in the Office Action. Note that in each case, a human assigns the valuation metric (which the reference says can be breadth of the patent claims). This is a teaching away from Applicants' invention.

The “Prophetic Example 2” referenced in the above excerpt is discussed at col. 13, beginning at line 31, also relies on human valuation. Risen references U.S. Patent No. 5,608,620 as teaching one suitable method for obtaining values of parameters. A copy of this reference has been provided in the accompanying Information Disclosure Statement. That reference describes a technique used by a group of forecasters. The abstract from 5,608,620 is reproduced below:

A method of eliciting an unbiased prediction of an unknown variable value from at least one of a group of forecasters. This method of compensating individual forecasters can be applied to an entire group of forecasters so as to elicit an unbiased collective prediction. The method yields nearly unbiased predictions from risk-averse forecasters whenever at least two forecasters are employed to make the same prediction. The method involves: aggregating the predictions of the forecasters, both with and without the particular prediction of the individual forecaster; computing collective losses for both of the aggregated predictions; calculating the individual forecaster's marginal contribution to predictive accuracy, based on the difference in collective losses; and computing and paying the individual forecaster's compensation as a function of the individual's marginal contribution.

The Prophetic Example 2 also references the “VALMATRIX” method of Trademark and Licensing Associates, Inc. In preparing the response to this

Office Action, Applicants conducted an internet search for VALMATRIX and found reference to this technique at:

www.consor.com/valuation/techniques.htm

A printout of the referenced page is included with this response. Applicants are not able to determine the date of the referenced page, hence no date has been provided for this document in Applicants' Information Disclosure Statement. However, Applicants find nothing in this reference that suggests the automatic determination of claim breadth metrics.

Excerpt B [col. 5, lines 7-10, col. 6, lines 1-10]

"The present invention provides for a sharing of the risk associated with the purchase, sale and/or ownership of intellectual property assets. Furthermore, the legal, technical and financial analysis which is conducted in connection with underwriting an insurance product to cover an intellectual property asset can also serve as a component in a "due diligence" analysis which is conducted in preparation for the purchase or sale of a business or portion of a business. Thus, the invention can provide the directors of a selling or purchasing company with protection against **claims** that they had incorrectly assessed the intellectual property of a company involved in an asset transfer. Non-limiting examples of situations in which the method and product of the invention would be useful are described below on Table 1. "

Excerpt B uses the term "claims" in the context of a "legal claim" or a "accusation" that an incorrect assessment has been made. This is, of course, not the same thing as "patent claims."

Excerpt C [col. 8, lines 45-51]

"When the intellectual property asset is a patent, the step of obtaining a "description of at least one intellectual property asset" which is recited in the **claims** generally entails obtaining a copy of the patent, and, in at least some cases, its file history. For other intellectual property assets, a description of the asset may entail a copy, sample, specimen, prototype, and/or written description of the asset."

Excerpt C further demonstrates that the Risen reference teaches away from Applicants' invention. Here Risen explains that an assessment of an intellectual property asset recited in the "claims" generally entails obtaining a copy of the patent, and, in at least some cases, its file history. There is nothing in the Risen reference to suggest that the file history would be analyzed automatically, thus it is apparent that Risen contemplates that a human would perform the claim breadth assessment.

Excerpt D [col. 8, lines 52-64]

"A first party" as this language is used in the **claims** refers to the owner (or in some cases the licensee) of the intellectual property asset or assets at the time that the asset or assets are valued. "A person with an interest in the first party" can be, for example, one or more of the parties listed in column 2 of Table 1 above, including the first party itself. Most frequently, this person will be a corporation which is a potential purchaser or licensee of the intellectual property asset or assets, the directors of the potential purchaser or licensee, or the officers of the potential purchaser or licensee, as these persons likely have a strong interest in obtaining a thorough analysis of the intellectual property asset or assets which they intend to purchase or license.

Excerpt D uses the term "claims" to refer to the claims of the Risen patent itself. This excerpt serves to define the term "a first party" and does not teach automatic claim breadth assessment.

Excerpt E [Table I]

"The directors and/or officers want to insure themselves in the event that current shareholders in Company A **claim** they sold the company for too low a price because they did not realize the value of the intellectual property. They also want insurance to cover any liability in the event that Company B or its owners **claim** that the Directors of Company A did not satisfy their due diligence requirement with respect to disclosure of information that could materially impact the value of the company.

* * *

In the resale or merger transaction, they want to insure against losses due to purchaser claims that they misrepresented the value of the intellectual property of Company A."

As with Excerpt C, Excerpt E deals with claims as meaning "legal claims" or "accusations" that a wrongdoing occurred.

Excerpt F

"The President of Company A wants insurance to cover the possibility that an investment in using the intellectual property covered by a provisional patent application (e.g. in building a plant to use a technology) will not be wasted or devalued because Company A could not obtain a valid patent with substantially the same claims.

* * *

The financiers (bankers, etc.) of Company A wants Company A to have insurance to cover the possibility that an investment in using the intellectual property covered by a provisional patent application (e.g. building a plant to use a technology) will not be wasted or devalued because Company A could not obtain a valid patent with substantially the same claims".

Excerpt F refers to the "claims" in the context of a provisional patent application. As the Examiner knows, the "claims" of provisional applications are not examined. Thus, this excerpt is referring to the situation where Company A has a provisional patent application with claims, and may later file a regular application based on the provisional. In the described scenario the claims in the provisional may not be allowed in "substantially the same" form as filed. (Thus Company A will not be able to get a valid patent with "substantially the same claims" as they had in their provisional application.) To answer this question would require an assessment of the claims vis-à-vis the prior art. By every indication in the Risen reference, this assessment would be done by a human.